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In re Application of: Bandman et al.

DEC 11 2002

Title: VESICLE TRAFFICKING PROTEINS

TECH CENTER 1600/2900

Serial No.: 09/556,178

Filing Date:

April 20, 2000

Examiner: Strzelecka, T.

Group Art Unit: 1637

**Box DAC**

Assistant Commissioner for Patents  
Washington, D.C. 20231

**PETITION UNDER 37 C.F.R. §1.181 TO REVIEW THE DECISION ON THE PETITION  
FROM REQUIREMENT FOR RESTRICTION**

Sir:

This is a Petition under 37 C.F.R. §1.181 to vacate the Decision on the Petition from Requirement for Restriction issued October 2, 2002 which stated that the Petition from Requirement for Restriction filed July 17, 2002 was denied. Applicants request review of the decision. Applicants request that the Commissioner vacate the Final Restriction Requirement and require the Examiner, upon searching and examining SEQ ID NO:1 and finding no prior art over which SEQ ID NO:1 can be rejected, to extend the search of the Markush-type claim to include the non-elected species SEQ ID NO:3 and SEQ ID NO:5.

**I. FACTS INVOLVED**

In Response to a Restriction Requirement mailed May 11, 2001, Applicants elected Claims 1, 2, 16, and 17 directed to polypeptides (Response mailed June 7, 2001). The claims are directed to an isolated polypeptide comprising an amino acid sequence selected from the group consisting of SEQ ID

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NO:1, SEQ ID NO:3, and SEQ ID NO:5. In addition, the Examiner, in the Restriction Requirement mailed May 11, 2001, required that Applicants **elect** “a single disclosed species” chosen among SEQ ID NO:1, SEQ ID NO:3, and SEQ ID NO:5. (Restriction Requirement mailed May 11, 2001, page 4, emphasis added.) In the Response filed June 7, 2001, Applicants stated that “[i]n the event that the Examiner insists upon only examining one of the claimed polypeptides, and therefore requires that only part of Applicants’ claims be elected, Applicants hereby provisionally elect the claims directed to the portion of claims 1, 2, 16, and 17 directed to the polypeptide of SEQ ID NO:1, and the variants and fragments thereof as presently claimed, with traverse.” (Response filed June 7, 2001, page 2, emphasis in original.) The Examiner, in the Office Action mailed August 13, 2001, stated that “Applicants are advised that the sequences presented in claims 1, 2, 16, and 17 are considered as distinct and independent inventions, **not species**, since SEQ ID NO: 1, 3, and 5 describe three different proteins with different structures and modes of action” and made the Restriction Requirement Final (Office Action mailed August 13, 2001, page 2, emphasis added). Applicants further traversed the Restriction Requirement in the Response filed January 14, 2002, but the Examiner reiterated the Final Restriction Requirement in the Final Office Action mailed April 17, 2002.

Applicants filed a Petition to the Commissioner on July 17, 2002 requesting that the Commissioner vacate the Final Restriction Requirement and require the Examiner, upon searching and examining SEQ ID NO:1 and finding no prior art over which SEQ ID NO:1 can be rejected, to extend the search of the Markush-type claim to include the non-elected species SEQ ID NO:3 and SEQ ID NO:5. The Petition was denied in a Decision mailed October 2, 2002. The Decision stated that “[f]rom applicants’ arguments, it appears that there is some confusion over whether the claims are subject to **restriction or election of species**. The second examiner clearly stated that the claims were restricted because each SEQ ID No. is an independent and distinct invention.” (Decision, page 2, emphasis added.)

The Decision then listed the claimed invention groups “for the sake of clarity . . . set forth below to reflect the position of the Office.” (Decision, page 2.) The claimed invention groups as listed in the Decision **restrict** Applicants’ claimed invention not only among polypeptides, polynucleotides, antibody, methods of detecting a target polynucleotide, methods of screening agonists and antagonists, and methods of screening expression altering compounds such, but also among SEQ ID NOs. The

Decision appear to indicate that the claims are not subject to an election of species, but rather to restriction between the SEQ ID NOs.

## II. POINTS TO BE REVIEWED

The prosecution record is not clear as to whether Applicants' choice of SEQ ID NOs for prosecution is an election of species or a restriction "between independent and distinct inventions." The Restriction Requirement requested that Applicants **elect "a single disclosed species"** chosen among SEQ ID NO:1, SEQ ID NO:3, and SEQ ID NO:5. (Restriction Requirement mailed May 11, 2001, page 4, emphasis added.) Following this language indicating that an election of species was requested, Applicants provisionally elected the portion of Claims 1, 2, 16, and 17 directed to the polypeptide of SEQ ID NO:1, and the variants and fragments thereof as presently claimed, with traverse in the Response filed June 7, 2001. However, in the Office Action mailed August 13, 2001, as well as the Final Office Action mailed April 17, 2002 and the Decision mailed October 2, 2002, the Office changed the originally made "election of species" requirement to an actual restriction requirement between the SEQ ID NOs.

If indeed an election of species was made (as indicated by the Restriction Requirement mailed May 11, 2001), the MPEP requires that "should no other prior art be found that anticipates or renders obvious the elected species, the search of the Markush-type claim will be extended." (MPEP §803.02.)

If indeed the Examiner has made a restriction between the sequences, as opposed to an election of species, Applicants note the following:

As discussed by Harold C. Wegner in "Appeal of a Withdrawal of a Linking Generic Claim"<sup>1</sup> (personal communication of a draft paper to be submitted for publication):

It has been axiomatic for more than 130 years since *Ex parte Eagle* that a restriction requirement should never be made against subject matter within a claim, but

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<sup>1</sup>Applicants are not citing Wegner's paper as authority *per se*, but rather crediting the argument made to its proper source; the citations in the argument are themselves the basis for the arguments.

rather between claims. [*In re Weber*, 580 F.2d 455, 459-60 (CCPA 1979) (Rich, J., concurring); *Ex parte Eagle*, 1870 C.D. 137 (Com'r Pats. 1870)] After a restriction requirement, the claims readable on the elected invention necessarily be examined.

Patent applicants have the right to present and have examined any generic claims that includes plural, patentably distinct species. There is no right of the Examiner to refuse to examine such a claim.

Thus, the Examiner always has the right to make either an election of species requirement or a requirement for restriction— whether in the end such an election or restriction requirement is correct and ultimately sustained. But, where a generic claim reads on the elected invention with or without other subject matter as well, the applicant has the right to an examination of the generic claim.

Furthermore, as discussed in *Weber*, it is an applicant's right, by statute, "to claim his invention with the limitations he regards as necessary to circumscribe that invention, with the proviso that the application comply with the requirements of §112." (*Weber* at 331.) The Court has further decided that §112, second paragraph "allows the inventor to claim the invention as he contemplates it." (*Weber* at 331.) The Court further explained that:

As a general proposition, an applicant has a right to have each claim examined on the merits. If an applicant submits a number of claims, it may well be that pursuant to a proper restriction requirement, those claims will be dispersed to a number of applications. Such action would not affect the right of the applicant eventually to have each of the claims examined in the form he considers to best define his invention. If, however, a single claim is required to be divided up and presented in several applications, that claim would never be considered on its merits. The totality of the resulting fragmentary claims would not necessarily be the equivalent of the original claim. Further, since the subgenera would be defined by the examiner rather than by the applicant, it is not inconceivable that a number of the fragments would not be described in the specification. (*Weber* at 331.)

Hence, it is improper for the Examiner to make a restriction requirement (as opposed to requesting an election of species) among SEQ ID NO:1, SEQ ID NO:3, and SEQ ID NO:5.

### III. ACTION REQUESTED

Applicants request that the Commissioner vacate the Final Restriction Requirement and require the Examiner, upon searching and examining SEQ ID NO:1 and finding no prior art over which SEQ ID NO:1 can be rejected, to extend the search of the Markush-type claim to include the non-elected species SEQ ID NO:3 and SEQ ID NO:5.



Docket No.: PF-0417-2 DIV

CONCLUSION

Applicant ~~believes~~ that no fee is due with this communication. However, if the USPTO determines that a fee is due, the Commissioner is hereby authorized to charge Deposit Account No. 09-0108.

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Respectfully submitted,  
INCYTE GENOMICS, INC.

TECH CENTER 1600/2900

Date: December 2, 2002

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